

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Thus, claim 45 has been cancelled, rendering moot the rejection of this claim under 35 U.S.C. §112.

Claim 1 has been amended to delete several of the groups under the definitions for Ra and Rb, the A groups, Y, W and the Z groups. Conforming amendments have been made in the dependent claims.

The patentability of the presently claimed invention after entry of the foregoing amendments, over the disclosures of the references relied upon by the Examiner in rejecting the claims, will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1-11, 16-22 and 31-46 under 35 U.S.C. §102(b) or 35 U.S.C. §103(a) based on Tamura et al. (US '303) is respectfully traversed.

After referring to the generic disclosure in this reference, the Examiner particularly cites compound 202 in Example 5 of the reference. [Referring to the middle of page 5 of the Office Action, Applicants assume the Examiner meant to refer to the reference compounds wherein $Y = CF_2H$ and $X = F$.] In these reference compounds referred to by the Examiner, the bonding group at ortho position to the substituent $-CF_2H$ on the benzene ring is $-CH_2O-$ or $-OCH_2-$. These bonding groups have an ether group.

In Formula (1) of the present invention, when m is 1, the bonding group at ortho position to substituent $-CF_2H$ on the benzene ring is Y, which does not include an ether bond. When m is 0, each of j and k is 0, and Ra, which is not hydrogen, alkoxy or alkoxymethyl, is at the ortho position to the substituent $-CF_2H$ on the benzene ring. Tamura et al. show a compound in which the bonding group at the ortho position to the substituent $-CF_2H$ on the benzene ring is $-CH_2O-$ or $-OCH_2-$. However, this reference does not show or suggest a compound in which the bonding group at the ortho position to the substituent $-CF_2H$ is a bonding group not having an ether bond.

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the Tamura et al. reference.

The rejection of claims 1-15, 23-30 and 36-46 under 35 U.S.C. §102(b) or 35 U.S.C. §103(a) based on DE 4,338,348 is respectfully traversed.

DE '348 discloses a very broad scope of compounds concerned the bonding group Z^1 in Formula (II), which encompass compounds of the present invention. However, a compound which was actually synthesized and for which properties are shown is a compound in which Z^1 is a single bond. A compound in which Z^1 is a bonding group other than a single bond is not disclosed in the working examples of DE '348.

On the other hand, a single bond is not included in the scope of W in Formula (2) of the present invention. W is a bonding group corresponding to Z^1 in Formula (II) of DE '348. Furthermore, DE '348 does not show that the compound in which Z^1 is a single bond has a large negative $\Delta\epsilon$ value equal to the compounds of the present invention.

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the DE '348 reference.

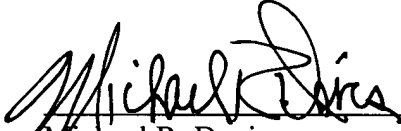
Accordingly, Applicants take the position that the rejections based on the Tamura et al. and DE '348 reference should be withdrawn.

The Examiner has rejected claims 1-11, 16-22 and 31-46 for obviousness-type double patenting as being unpatentable over claims 1-36 of USP 7,306,831; and has also provisionally rejected these claims for obviousness-type double patenting as being unpatentable over claims 1-30 of Serial No. 11/108,002. The Examiner is kindly requested to hold both of these double patenting rejections in abeyance, pending an indication that the claims of the present application are otherwise in condition for allowance.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

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